

REMARKS

Claims 11-22 stand rejected. Claims 11-16 have been cancelled without prejudice. Claims 18-22 are amended. Claim 23 is added. Claims 17-22 and 23 remain pending in the application.

Support for added Claim 23 is found in the specification and drawings. No new matter is added.

112 Rejections:

The Examiner rejected Claims 15, 16, and 18-22 as not further limiting the method claims from which they depend. Claims 18-22 have been amended to more clearly set forth the method recited in each claim. Withdrawal of the rejection is requested.

103 Rejections:

Claims 17-19, 21, and 22 are rejected as unpatentable over Schramm et al. '101' in view of Silverman. This rejection is improper for at least the following reasons.

It is respectfully urged that the Examiner has not met the burden of providing a prima facie case of obviousness. A prima facie case of obviousness requires that three basic criteria be met: 1. There must be some suggestion or motivation in the prior art to modify a reference or combine reference teachings; 2. There must be a reasonable expectation of success; and 3. The references when combined must teach or suggest all the claim limitations. (See MPEP 2143).

No Motivation to Combine:

As noted in the previous response, Schramm et al. '101 does not teach an inner member having a distal portion biased to expand radially at its distal end. Nor does Schramm et al. 101 teach or suggest an inner member distal portion that expands radially as the inner member moves distally relative to the outer member. Rather, Schramm et al. '101 teaches a first needle 86 and a

second needle 96. Schramm et al. '101 further states that first needle 86 is a substantially solid shaft 87 with a tissue holding region 90 cut-out from shaft 87. (See Column 11, lines 50-62). It is respectfully urged that the substantially solid shaft 87 of Schramm et al. '101 does not teach or suggest expansion.

Nor does Schramm et al. '101 teach or suggest an inner member having a distal end portion that is closed radially by relative movement of the inner member and the outer member.

Further Schramm et al. '101 seems to teach away from the invention as claimed, as Schramm et al. '101 teaches that the inner needle is exposed at all times (see Schramm et al. '101' at column 12, lines 2-5 and lines 12-18 explaining the point of the inner needle is exposed at all substantial times of operation).

Because Schramm et al. '101 teaches an inner needle with a point that is exposed during operation, it is respectfully urged that one would not be motivated to combine Schramm et al. '101 with Silverman in the manner suggested by the Examiner. Instead, it is respectfully urged that the Examiner has improperly relied on the Applicants' teachings in hindsight in an effort to modify Schramm et al. in a manner that is counter to the teachings of Schramm et al.

Further, it is not clear how the resulting combination would operate. For example, Schramm et al. teaches the inner needle is exposed and used to penetrate tissue. If one combines the references as suggested by the Examiner, such that the split needle of Silverman replaces the solid inner needle of Schramm et al., then the split needle would be exposed and presumably at least partially expanded, even during insertion into tissue. It is respectfully urged that without further modification or teaching, the combination suggested by the Examiner would not be consistent with the teachings of Schramm et al. '101.

It is also respectfully urged that the references, even if combined would not teach the step of moving the distal end portion of the inner member from a point inside the outer hollow cannula with the at least one mechanism to a position distal of the distal end of the outer hollow cannula to expand the distal end portion of the inner member, as recited in newly added Claim 23.

With respect to Claim 20, which depends from Claim 17, it is respectfully urged that the Examiner has not shown how one would be motivated to combine the end features of Reznick et al. to the exposed inner needle of Schramm et al. particularly as it would seem one would not want to have "hooked extractors" exposed at the end of the Schramm et al. device.

Conclusion:

The Examiner is requested to reconsider the pending claims in light of the Remarks above, and to allow the claims in the next office action.

Respectfully submitted,


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